

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on February 10, 2006, the Examiner rejected claims 1-9 under 35 U.S.C. §103(a) as being unpatentable over Zohmann, U.S. Patent No. 6,558,353 in view of Eldor, U.S. Patent No. 5,848,996. The Examiner also rejected claims 1-9 under 35 U.S.C. §103(a) as being unpatentable over Zohmann in view of Sorenson et al., U.S. Patent Application No. 2002/0123723. Accordingly, Applicant respectfully provides the following.

Claim Objections

In accordance with the Examiner's request, Applicant replaced "said needle" with "said needle apparatus" in claim 1.

Claim Rejections under 35 U.S.C. §103(a).

As noted above, the Examiner rejected claims 1-9 under 35 U.S.C. §103(a) as being unpatentable over Zohmann in view of Eldor and over Zohmann in view of Sorenson. In response, Applicant amended independent claims 1, 5 and 7 and provides the following remarks.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142.

Zohmann and Eldor

The Examiner admits that Zohmann does not disclose a plurality of fenestrations. Eldor discloses a “double-hole pencil-point (DHPP) spinal needle” that has two circular coaxial holes. See Abstract; col. 3, lines 62-67. Zohmann also teaches that one object of his invention is to provide a spinal needle that doubles the rapid cerebral spinal fluid reflux. See Col. 2, lines 35-37. Thus, Eldor’s addition of multiple holes is very specific and limited in number (2) and use (on a spinal needle). In light of the Examiner’s rejection, Applicant amended independent claims 1, 5 and 7; adding the limitation of “at least three fenestrations.” Thus, because the combination of Zohmann and Eldor does not teach every limitation of the claimed invention, Applicant respectfully requests that the Examiner withdraw his Section 103 rejection.

Zohmann and Sorenson

In light of the Examiner’s rejection, Applicant amended independent claims 1, 5 and 7, adding the limitation that the fenestrations are isolated on a distal end of the fenestrated needle. This is very different than the plurality of perforations disclosed in Sorenson that release anesthetics along its entire length so that it uniformly disperses medication to a treatment zone. See page 3, paragraph 33. Sorenson specifically differentiates itself from the “point-source” fluid introduction of other devices. In contrast to the broad, uniform release strategy of Sorenson, the present invention focuses on precisely placing its injections in order to avoid intravascular injection and/or inadvertent penetration of a nerve. See Application, page 3, lines 20-22. Thus, it would be dangerous to apply the teachings of Sorenson to the present invention, as application of Sorenson’s invention would likely send anesthetic outside the boundaries of the well defined fascial compartments in which Applicant directs the anesthetic. Therefore, because

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the combination of Zohmann and Sorenson does not teach every limitation of the claimed invention, Applicant respectfully requests that the Examiner withdraw his Section 103 rejection.

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CONCLUSION

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

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Respectfully submitted,

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